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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,362	02/16/2000	David Clive Williams	49592 (1878)	6693

7590 06/18/2003

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EXAMINER

FORD, JOHN M

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/506362

Applicant(s)

Williams et al

Examiner

J.M. Ford

Group Art Unit

1624

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on May 5, 2003

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 33--42 and 45-48 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 33--39 and 45--47 is/are allowed.

☒ Claim(s) 40, 41, 42 and 48 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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Applicants response of May 15, 2003, is noted.

The claims in the application are claims 33--42 and 45--48.

Applicants response is noted. Note claim 45 is allowed.

The open breadth of all cell lines cannot be allowed, as noted in the rejection of claim 40 in the prior action. Claims 40--42 remain rejected, for the reasons of record.

Claims 48 and 41 are rejected, as not provided for by the statute. Applicants are presenting compound claims in a method claim. This appears to be a back door attempt to repeat compound claim 38. It is not believed proper to mix statutory classes of invention by claiming compound claims, through dependency on a method claim.

The previous Office Action position is maintained. There are many different cancer cell lines; no one compound is likely to be effective for all of them. Note particularly, In re Hozumi, 226 USPQ 353.

Applicants got a claim commensurate in scope with what they say they show. You get what you show in a ~~sensitive~~ area of utility, such as cancer, not more.

Note the article on cell lines by Robin McKie in the "Observer" on June 10, 2001.

There are many different cancer cell lines. The "Observer" raises the question of what cells the researcher really has, and how dependable are the reported result.

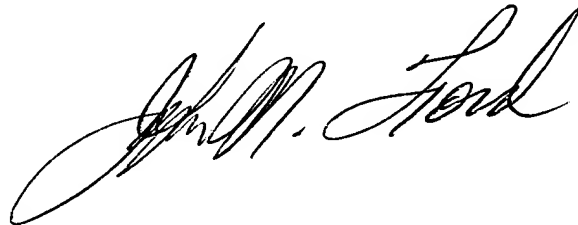
"The factors to be considered [in making an enablement rejection] have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art,

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the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims”, In re Rainer, 146 USPQ 218 (1965); In re Colianni, 195 USPQ 150, Ex parte Forman, 230 USPQ 546. a) Determining if any particular cancer would be treatable with Applicants' compounds would require clinical trials in each disease with each compound. Considering the thousands of compounds covered by formula I and the multitude of different cancers, this is a very large degree of experimentation.

John M. Ford:jmr

June 12, 2003



JOHN M. FORD  
PRIMARY EXAMINER

*Group Art Unit 1624*